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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | ************************************** | |
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| 10/004,564 | 12/05/2001 | Akira Takahashi 70904-56737 | | 7094 | |
| 75 | 90 07/30/2002 | · | | | |
| | n Roberts & Cushnian | EXAMINER | | | |
| | perty Practice Group | CAO, ALLEN T | | | |
| Edwards & Angell P O Box 9169 | | | | | |
| Boston, MA 02 | 2209 | | ART UNIT | PAPER NUMBER | |
| • | | | 2652 | | |
| | | | DATE MAILED: 07/30/2002 | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | Application | | Applicant(s) | | | |
| • | • | 10/004,564 | | TAKAHASHI ET AL. | | | |
| Office Action Summary | | Examiner | | Art Unit | | | |
| • | | Allen T Cao | | 2652 | | | |
| Period fo | The MAILING DATE of this communication app or Reply | pears on the cove | r sheet with the c | orrespondence add | ress | | |
| THE - External after - If the - If NC - Failur - Any I | ORTENED STATUTORY PERIOD FOR REPL' MAILING DATE OF THIS COMMUNICATION. nsions of time may be available under the provisions of 37 CFR 1.1 SIX (6) MONTHS from the mailing date of this communication. period for reply specified above is less than thirty (30) days, a reply period for reply is specified above, the maximum statutory period or re to reply within the set or extended period for reply will, by statute reply received by the Office later than three months after the mailing ad patent term adjustment. See 37 CFR 1.704(b). | 36(a). In no event, howe y within the statutory min will apply and will expire , cause the application t | ever, may a reply be tim nimum of thirty (30) days SIX (6) MONTHS from to become ABANDONEI | nely filed s will be considered timely. the mailing date of this com O (35 U.S.C. § 133). | nmunication. | | |
| 1) | Responsive to communication(s) filed on | <u></u> • | | | | | |
| 2a) <u></u> ☐ | This action is FINAL. 2b)⊠ Th | is action is non-fi | nal. | | | | |
| 3) | Since this application is in condition for allowards closed in accordance with the practice under | ance except for fo Ex parte Quayle, | ormal matters, pr 1935 C.D. 11, 4 | osecution as to the 53 O.G. 213. | merits is | | |
| | on of Claims | | | | | | |
| • | Claim(s) <u>1-26</u> is/are pending in the application | | | | | | |
| | 4a) Of the above claim(s) is/are withdrav | wn from consider | ation. | | | | |
| | Claim(s) is/are allowed. | | | | | | |
| | Claim(s) <u>1-6,8-22 and 24-26</u> is/are rejected. | | | | | | |
| _ | Claim(s) 7 and 23 is/are objected to. | | | | | | |
| 8)∐ Applicati | Claim(s) are subject to restriction and/o on Papers | r election require | ment. | | | | |
| 9) 🗌 🤈 | The specification is objected to by the Examine | r. | | | | | |
| 10) 🗌 . | The drawing(s) filed on is/are: a)□ accept | oted or b) 🔲 object | ed to by the Exar | niner. | | | |
| | Applicant may not request that any objection to the | | • | , , | | | |
| 11) 🗌 . | The proposed drawing correction filed on | | | ved by the Examiner | • | | |
| | If approved, corrected drawings are required in rep | • | tion. | | | | |
| | The oath or declaration is objected to by the Ex | aminer. | | | | | |
| | ınder 35 U.S.C. §§ 119 and 120 | | | | | | |
| | Acknowledgment is made of a claim for foreign | n priority under 3 | 5 U.S.C. § 119(a) |)-(d) or (f). | | | |
| a)[| ☐ All b)☐ Some * c)☐ None of: | | | | | | |
| | 1. Certified copies of the priority documents | | | | | | |
| | 2. Certified copies of the priority documents have been received in Application No | | | | | | |
| * 9 | 3. Copies of the certified copies of the prior application from the International Buse the attached detailed Office action for a list | reau (PCT Rule 1 | l7.2(a)). | | tage | | |
| | cknowledgment is made of a claim for domesti | | | | application). | | |
| _a |) ☐ The translation of the foreign language pro Acknowledgment is made of a claim for domesti | visional applicati | on has been rec | eived. | | | |
| Attachmen | | , , , | | · · · · · · · · · · · · · · · · · · · | | | |
| 1) Notic | e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PTO-948) nation Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> | 4) | | (PTO-413) Paper No(s) Patent Application (PTO- | | | |
| S. Patent and To TO-326 (Re | | tion Summary | | Part of F | Paper No. 5 | | |

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1. Claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a) The phrases "a side" and "the side" in claim 2 are vague and indefinite because its lack antecedent basis. It is unclear as whether applicant refers to the side as claimed in claim 1 or a different "side".
- b) The phrase "can be" in claim 8 is vague and indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention or not, and the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.
- 2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 3. Claims 1, 3-4, 9 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Mistretta (US. 5,548,571).

Mistretta discloses a disc cartridge 8 having a disc 6 in a disc shape, including a recording layer for recording/reproducing information; a disc cover 12 for covering at least a part of one side of the disc (aperture 13 for holding the disc 6); and a "connecting" means for connecting the disc and the disc cover (spring 13, 16; see column 1, lines 51-54); wherein a side of the disc,

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which is opposite to the side of the disc covered by the disc cover, is exposed externally (figures 1 and 2) as set forth in claims 1, 9, 17 and 19-20.

Regarding claim 3, Mistretta discloses that the disc cover includes an outer touching section that touches the disc in a vicinity of an outer circumference thereof when the disc cover is connected with the disc (see elements 13, 16 which is an outer touching section that touches the disc in a vicinity of an outer circumference of the disc).

Regarding claim 4, Mistretta discloses that the outer touching section is made of an elastic material (spring is inherently an elastic material).

Regarding claim 16, Mistretta discloses that the disc cover is made of metal (column 4, lines 31-32).

Regarding claim 18, Mistretta inherently discloses that the disc cover has a region which has no side wall in "at least" part of the outer circumference of the disc cover.

- 4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 5. Claims 2, and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mistretta in view of Lee et al (US. 5,202,880).

Mistretta discloses a disc; however Mistretta does not disclose a disc having such limitations as set forth in claim 2.

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Lee et al disclose a disc having a disc substrate 110, the recording layer 140, and a protective layer 150, which is transparent, in this order; wherein at least a part of a side of the disc, on which the protective layer 150 is formed, is covered by the disc cover so that the side of the disc on the disc on which the protective is formed is subjected to light projected thereon, so as to record/reproduce information.

Regarding claim 10, Lee et al disclose that the protective layer has a thickness ranging from 0 to 20 micrometers (column 8, lines 46-49).

Regarding claims 11 and 12, Lee et al disclose that the substrate is made of a glass material (column 6, line 66) which is inherently anti-static because glass is not a static material.

Regarding claims 13-15, Lee et al inherently disclose that the protective layer is made of a glass or resin material because glass or resin is one type of a transparent material and which is inherently slippery and anti-static.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the disc of the disc cartridge of Mistretta with such limitations as set forth, supra as taught by Lee et al as an obvious engineering routine choices.

6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mistretta in view of Iizuka et al (US. 4,677,516).

Regarding claims 5 and 6, Mistretta does not disclose an inner touching section, made of an elastic material, that touches the disc in a vicinity of an inner circumference thereof when the disc cover is connected with the disc.

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Iizuka et al disclose a disc cartridge having an inner touching section (24 and 25), made of an elastic material, that touches the disc in a vicinity of an inner circumference thereof when the disc cover is connected with the disc.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the disc cartridge of Mistretta with such inner touching section as taught by Iizuka et al to reduce the thickness and reduce the dust.

7. Claims 21-22 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mistretta in view of Ma et al (US. 5,537,281).

Mistretta discloses a disc cartridge 8 having a disc 6 in a disc shape, including a recording layer for recording/reproducing information; a disc cover 12 for covering at least a part of one side of the disc (aperture 13 for holding the disc 6); and a "connecting" means for connecting the disc and the disc cover (spring 13, 16; see column 1, lines 51-54); wherein a side of the disc, which is opposite to the side of the disc covered by the disc cover, is exposed externally (figures 1 and 2) as set forth in claims 21-22 and 24--26.

Mistretta does not disclose a separating means for separating the disc and the disc cover, so as to allow the head to be inserted between the disc and disc cover so that the recording/reproducing is performed as claimed in claim 21. Nor does Mistretta disclose a shutter closing/opening for closing/opening the cartridge shutter as set forth in claim 24.

Ma et al disclose a disc cartridge apparatus having a separating means for separating the disc 14 and the disc cover 12 so as to allow the head 42a to be inserted between the disc and disc

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cover so that the recording/reproducing is performed; and a cartridge shutter for closing/opening the cartridge shutter.

Regarding claim 22, Ma et al disclose a spindle for rotating the disc; wherein the separating means acts as moving means for moving the disc cover in a direction of a rotation axis of the disc, while leaving the disc on the spindle motor, so as to separate the disc and the disc cover, when the disc cartridge is inserted to be placed on the spindle motor (figures 1a, 1b and 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the disc cartridge system of Mistretta with such limitations as set forth, supra as taught by Ma et al to improve the read/write characteristics of the drive system.

- 8. Claims 7 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
- 9. Claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
- 10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Watanabe et al (US. 6,339,583 B1), Dang (US. 5,581,540), Nagaura et al (US. 5,587,994), Iwasaki (US. 6,338,104 B1), Saito et al (US. 6,379,768 B1), and Misawa et al (US. 5,948,593).

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen Cao whose telephone number is (703) 305-3796.

Mencin ALLEN CAO PRIMARY EXAMINER

AC

July 25, 2002